# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/028,122 | 12/21/2001 | Jakobus Middeljans | PHNL 000755 | 3210 |

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|---|---|---|
| 24737     7590     02/03/2006 | | EXAMINER |
| PHILIPS INTELLECTUAL PROPERTY & STANDARDS | | NELSON, FREDA ANN |
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| BRIARCLIFF MANOR, NY 10510 | ART UNIT | PAPER NUMBER |
| | 3639 | |

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/028,122 | MIDDELJANS ET AL. |
| | Examiner | Art Unit |
| | Freda A. Nelson | 3639 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>*18 November 2005*</u>.

2a)☒ This action is **FINAL.**     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-12,14 and 16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12, 14,a nd 16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)          Office Action Summary          Part of Paper No./Mail Date 01272006

## DETAILED ACTION

The amendment received on November 18, 2005 is acknowledged and entered.

Claim 1 has been amended. Claims 13 and 15 have canceled. No claims have been

added. Claims 1-12 and 14-16 are currently pending.


### *Response to Amendment and Arguments*

Applicant's arguments filed November 18, 2005 have been fully considered but

they are not persuasive.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., "methodology that associates the acknowledgement (ACK) for the regular flow of

packets for use as payment tokens, wherein the flow of packets makes up the digital

work") are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1, 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is

unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Regarding claim 14, the phrase "such as" renders the claim indefinite because it

is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Regarding claim 16, the phrase "such as" renders the claim indefinite because it

is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.      Claims 1-1, 14 and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Stefik et al. (Patent Number 6,236,971) in view of Griswold (Patent

Number 5,940,504).

As for claims 1-2 and 4, Stefik et al. disclose a process for controlling delivery of
digital works across a communication channel such as the Internet wherein there is to
be paid for the content of said digital works, wherein the process is executable on a
server computer and a client computer, said process comprising the steps of:
a) configuring for delivery of the content of a digital work between the server and
the client, via a regular flow of packets  (col. 5, lines 44-48) {FIG. 19 is a state diagram
of server and client repositories in accordance with a transport protocol followed when
moving a digital work from the server to the client repositories};

b) creating at the server and executing the regular flow of packets, wherein the packet size is less than the total size of said digital work, of said content from the server to the client using a transmission or transport protocol, wherein the client is requested to acknowledge the received packets (col. 32, line 66 through col. 33, line 5) {the server enters a data transmit state 1906 and transmits a block of data 1907 and then enters a wait for acknowledgement state 1908; and as the data is received, the requesters enters a data receive state 1909 and when the data blocks is completely received it enters an acknowledgement state 1910 and transmits an Acknowledgement message 1911 to the server};

c) initiation of a return traffic of acknowledgement codes (ACKs) by the client to the server wherein a payment token is associated with each acknowledgement code or with a number of acknowledgement codes (col. 9, lines 14-26; col. 33, lines 6-11) {by enabling control and fee billing to be associated with each node, a creator of a work can be assured that the rights and fees are not circumvented; {if there are more blocks to send, the server waits until receiving an Acknowledgement message from the requester and when an Acknowledgement message is received it sends the next block to the requester and again waits for Acknowledgement wherein the requester also repeats the same cycle of states};

d) validation by the server that each acknowledgement code requested of the client is received by the server (col. 33, lines 56-64) {Two-phase commit works as follows:  the server sends all of the data to the requester and both repositories mark the transaction (and appropriate files) as uncommitted; the server sends a ready-to-commit message to the requester; the requester sends back an acknowledgement; the server then commits and sends the requester a commit message; and when the requester receives the commit message, it commits the file};

e) continuation of the flow of said content by the server only if the acknowledgement codes requested of the client are received as specified by the server (col. 33, lines 6-11) {if there are more blocks to send, the server waits until receiving an Acknowledgement message from the requester and when an Acknowledgement message is received it sends the next block to the requester and again waits for Acknowledgement wherein the requester also repeats the same cycle of states}.

Stefik et al. does not disclose f) accumulation of payment tokens received from the client in a pay-for-each-packet-received-as-acknowledged-by-the-client mode of operation and g) arrangement of billing of and payment by the client for all received packets on the basis of at least said accumulated payment tokens.  Griswold discloses that a licensed product generates a request datagram after each period of product use and the number of request datagrams received by the licensor can be used to bill the licensee, for example, if datagrams are sent after every hour of product use, the licensee will be billed for the amount equal to the number of request datagrams received by the licensor multiplied by the hourly rate (col. 4, lines 37-40).  Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Stefik et al. to include the feature of Griswold in order to permit the user to pay for the digital work(s) once all transmissions are complete rather than at the end of each transmission.

2.      As for claim 3, Stefik et al. disclose a process for controlling delivery of digital works across communications channel according to claim 1, wherein in step (e) continuation of the flow of packets with content by the server occurs wherein a certain number of packets may be transmitted while a number of acknowledgment codes in transit less than or equal to another pre-determined number of acknowledgment codes encompassed in the credit window have not yet been received by the server (col. 32, lines 48-53; col. 32, lines 60-65) { FIG. 19 is a state diagram showing steps in the process of transmitting information during a transaction wherein each box represents a state of a repository in either the server mode (above the central dotted line 1901) or in the requester mode (below the dotted line 1901); this message includes transaction information including a transaction identifier and a count of the blocks of data to be transferred; and the requester, initially in a wait state 1904 then enters a data wait state 1905; and FIG. 19, the server is initially in a state 1902 where a new transaction is initiated via start message 1903}.

3.      As for claims 5 and 16, Stefik et al. disclose the process according to claim 1 for use in conducting business operations or commercial transactions, comprising regulation of payment based on received return traffic (col. 1, lines 49-54) {the transmission of digital works over networks is commonplace wherein one such widely used network is the Internet; and the Internet is a widespread network facility by which computer users in many universities, corporations and government entities communicate and trade ideas and information}.

4.      As for claim 6, Stefik et al. disclose the process according to claim, 5 for use in conducting business operations or commercial transactions, wherein in addition billing is dependent on the transmission rate and/or on the length of the transmission session and/or on the loss rate of the transmitted digital packets(col. 23, lines 38-43; col. 23, lines 15-18) {the grammar differentiates between uses where the charge is per use from those where it is metered by the time unit; and transactions can support fees that the user pays for using a digital work as well as incentives paid by the right grantor to users to induce them to use or distribute the digital work; and Grammar element 1521 "Metered-Rate-Spec: =Metered: Money-Unit Per: Time-Spec" defines a metered-rate fee paid according to how long the right is exercised which is the time it takes to complete the transaction determines the fee}.

5.      As for claims 7-9, Stefik et al. disclose a method of sending and/or receiving packets by a system comprising a server and a client, said method comprising one or more steps including at least step (c) or step (e) of a process according to claim 1 (col. 34, lines 6-12; (col. 17, lines 20-22) {the server could use an additional level of encryption when transmitting a work to a client wherein only after the client sends a message acknowledging receipt does it send the key; and the client then agrees to pay for the digital work in order to provide a clear audit trail that the client received the work;

and in another embodiment, the credit server acts as a "debit card" where transactions occur in "real-time" against a user account}.

6.     As for claims 10-12, Stefik et al. discloses a computer programme stored on a computer readable medium comprising instructions, which instructions include at least code defining the processes or functions to be performed with respect to acknowledgement codes and payment tokens associated with said acknowledgement codes, for causing a programmable processing apparatus having or being connected to transmission hardware to become operable to execute the method (col. 14, lines 25; FIG. 12) {the processor memory 1202 would typically be further comprised of Read Only Memories (ROM) and Random Access Memories (RAM) wherein such memories would contain the software instructions utilized by the processor element 1201 in performing the functions of the repository}.

7.     As for claim 14, Stefik et al. disclose a computer programme according to claim 10 with or in a transmissible carrier such as an electrical or optical signal (col. 14, lines 43-48) {the external interface means 1206 provides for the signal connection to other repositories and to a credit server wherein the external interface means 1206 provides for the exchange of signals via such standard interfaces such as RS-232 or Personal Computer Manufacturers Card Industry Association (PCMCIA) standards, or FDDI; and the external interface means 1206 may also provide network connectivity}.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP

§ 706.07(a).  Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

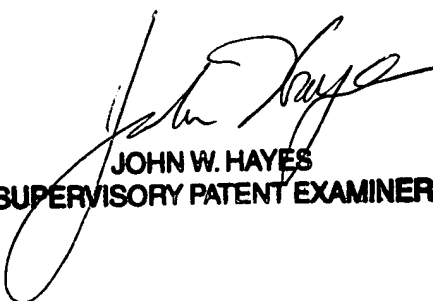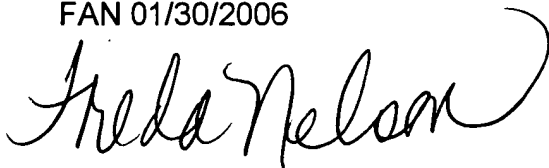extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 01/30/2006

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER